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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

CHIN, RANDALL E

ART UNIT PAPER NUMBER

1744

DATE MAILED: 09/26/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

4

Office Action Summary	Application No. 10/656,409	Applicant(s) D'AGUANNO, FRANCIS D.	
	Examiner Randall Chin	Art Unit 1744	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-8 and 10-13 is/are rejected.
- 7) ☒ Claim(s) 9 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Drawings

1. The drawings are objected to because it appears the lead line for numeral **21** (i.e., straight section **21** as recited on p. 7, lines 9-10) is misdirected.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

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2. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description: Reference numeral **31** as shown in Fig. 1b and 3.

Corrected drawing sheets in compliance with 37 CFR 1.121(d), or amendment to the specification to add the reference character(s) in the description in compliance with 37 CFR 1.121(b) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

3. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: Slot **22** as recited on p. 7, line 6, pin **34a** as recited on p. 8, lines 12 and 13, and pin **35a** as recited on p. 8, line 12.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet

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submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

4. The disclosure is objected to because of the following informalities:

On p. 7, lines 14-21, there are two (2) recitations of a "tapered" arrangement (line 17 and 20) and the **description is unclear** as to whether these two "tapered" recitations are referring to the same structural feature or is descriptive of **two separate** features. Please see Figs. 1b and 3.

On p. 8, line 13, the recitation "pins 34a, 34b" appears incorrect since only pins 34a and 35a have been previously set forth (see p. 8, lines 1-13).

On p. 9, line 18, it appears "slot 26" should read --slot 36-- (see p. 9, line 7).

On p. 9, line 21, "the any material" is awkwardly written.

Appropriate correction is required.

Claim Objections

5. Claim 3 is objected to because of the following informalities:

Claim 3, line 3, it appears "another" should read --the other-- for clarity. Please compare with claim 12, line 3.

Appropriate correction is required.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1-5, 7 and 8 are rejected under 35 U.S.C. 102(b) as being anticipated by Whiting 2,106,584 (hereinafter Whiting).

The patent to Whiting discloses a foldable hand tool (Fig. 1) having an open position (Fig. 1) and a closed position (Fig. 6), comprising a first section 5 having a first inner side, a second section 6 having a second inner side, and a connector section at 4, 7, 8, said connector section connected pivotably to said first section 5 at a first connection point 7, and said connector section connected pivotably to said second section 6 at a second connection point 8, wherein said first connection point and said second connection point are spaced from one another (Fig. 1) and positioned such that said first inner side of said first section is capable of contacting said second inner side of said second section when said tool is in the closed position (Fig. 6).

As for claim 2, a protruding member defined by jaw 2 is affixed to the first section 5 (Figs. 1 and 3).

As for claim 3, an alignment member at 4 (Fig. 3) affixed (at least indirectly) to one of said first and second sections; and a recess in the other of said one of said first

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and second sections, wherein said recess cooperates with said alignment member to assure proper alignment (Fig. 6) of said first section and said second section when the device is in the closed position.

As for claim 4, said alignment member and said recess are cylindrical in shape (Figs. 3 and 6).

As for claim 5 reciting that the tool is a device for cleaning and reconditioning grooves on a golf club head, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

As for claim 7, said protruding member 2 is completely encapsulated in the closed position (Fig. 6).

As for claim 8, said protruding member 2 comprises a "blade" (i.e., can be a wall of jaw 2 as can be seen in Fig. 3).

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Whiting.

As for said first section and said second section each being approximately 2 inches in length (if not already), it would have been obvious to one of ordinary skill in the art to have modified Whiting's first and second sections to be of such a length in order to be sufficiently graspable by a user without slippage during manipulation.

10. Claim 10 is rejected under 35 U.S.C. 102(b) as being anticipated by Palamara 4,482,263 (hereinafter Palamara).

The patent to Palamara discloses a foldable hand tool (Figs. 1-3), said tool having an open position (Fig. 2) and a closed position (Fig. 3), said tool comprising a first section 16 having a first inner side, a second section 17 having a second inner side, a protruding member defined by brush 12 affixed to said first section 16, a trough or slot 13 disposed in said second section 17 and configured to receive said protruding member 12 (Fig. 3) when said tool is in said closed position, and a connector section at living hinge 15 connected pivotably to said first section 16 at "a first connection point" (merely a **point** which can be at one end of living hinge 15) opposite said protruding member, said connector section further being connected pivotably to said second section at a second connection point (merely a **point** which can be at an opposite end of living hinge 15) opposite said slot, wherein said first connection point and said second connection point are spaced from one another and positioned such that said first inner side of said first section is capable of contacting said second inner side of said second section when said tool is in the closed position (Fig. 3)

As for cleaning grooves of golf clubs, a recitation of the intended use of the

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claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

11. Claims 10-13 are rejected under 35 U.S.C. 102(b) as being anticipated by Warren 416,526 (hereinafter Warren).

The patent to Warren discloses a foldable hand tool (Figs. 1-3), said tool having an open position (Fig. 1) and a closed position (Fig. 2), said tool comprising a first section A having a first inner side, a second section C having a second inner side, an arm or protruding member B affixed to said first section A, a recess or slot D disposed in said second section C and configured to receive said protruding member 12 (Fig. 2) when said tool is in said closed position, and a connector section connected pivotably to said first section A at "a first connection point" O opposite said protruding member, said connector section further being connected pivotably to said second section at a second connection point O opposite said slot, wherein said first connection point O and said second connection point O are spaced from one another and positioned such that said first inner side of said first section is capable of contacting said second inner side of said second section when said tool is in the closed position (Fig. 2).

As for cleaning grooves of golf clubs, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior

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art. If the prior art structure is capable of performing the intended use, then it meets the claim.

As for claim 11, said protruding member comprises an arm or blade B.

As for claim 12, Warren teaches a closed position of the tool in Fig. 2. When the tool is closed an "alignment member" a affixed to first section A which cooperates with a back of blade. It is the position of the Examiner that one skilled in the art would find it obvious to provide for a recess being configured to cooperate with said alignment member to assure proper and secure alignment of said first section and said second section when the tool is in the closed position (already shown in Fig. 2). Such arrangement is already suggested by Warren at a different location where a pin or "alignment member" b cooperates with recess e (Figs. 2 and 3). As for claim 13, accordingly, the pin and alignment member are cylindrical in shape, and said alignment member is capable of being seated, at least partially, into said recess when said tool is closed.

Allowable Subject Matter

12. Claim 9 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

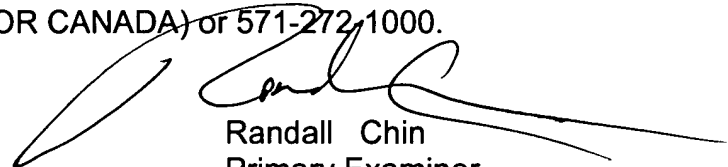
13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The references to Godfrey, Ping, Nian, Ibelli, Heilrath, Kinney, Schwartz, and Hainey are relevant to various pivoting tools or scraper configurations for golfers.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Randall Chin whose telephone number is (571) 272-1270. The examiner can normally be reached on Monday through Thursday and every other Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gladys Corcoran can be reached on (571) 272-1214. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Randall Chin
Primary Examiner
Art Unit 1744